

REMARKS

The Official Action mailed May 4, 2004, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

Claims 1-10, 12-33, 35-44 and 45-56 were pending in the present application prior to the above amendment. Claims 1-10, 12-30 and 54 have been canceled, claims 31 and 43 have been amended to better recite the features of the present invention and new claims 57 and 58 have been added to recite additional protection to which the Applicant is entitled. Accordingly, claims 31-33, 35-44, 46-53 and 55-58 are now pending in the present application, of which claims 31 and 43 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 3 of the Official Action rejects claims 31-33, 35-44, 46-53, 55 and 56 under 35 U.S.C. § 112, first paragraph, asserting that the claims fail to comply with the written description requirement (page 2, Paper No. 20040430). The Official Action further asserts that independent claims 31 and 43 introduce new matter (page 3, Id.), because the present specification allegedly "does not provide support for a second substrate 'opposing to said first substrate' having "a second circuit under said second substrate' which is connected to the first substrate by the claimed 'connecting wiring'" (page 2, Id.). The Applicant respectfully disagrees and traverses the above assertions in the Official Action

The Official Action appears to consider the substrate 250 as the second substrate (page 2, Id.). However, the Applicant respectfully submits that, for example, in Figures 12A and 12B, the substrate 191a provided with the FPC 191 may be the second substrate as claimed. In the claims, a first substrate may, for example, be the active matrix substrate 101 and a second circuit may, for example, be the wiring of the FPC 191b. These features are supported in the specification by, for example, Figures

12A and 12B and page 33, lines 7-19. Therefore, the Applicant respectfully submits that claims 31-33, 35-44, 46-53, 55 and 56 are adequately described in the specification. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

Paragraphs 5-13 of the Official Action continue to reject claims 31-33, 35-44, 46-53, 55 and 56 as obvious based on the combination of JP 9-251996 to Yamazaki et al. with one or more of the following: U.S. Patent No. 6,169,593 to Kanaya et al., U.S. Patent No. 5,636,329 to Sukegawa et al., and U.S. Patent No. 5,608,559 to Inada et al. The Official Action also relies on U.S. Patent No. 5,821,159 to Ukita, U.S. Patent No. 6,215,077 to Utsumi et al., and JP 8-234212 to Hioki to allegedly teach the features of some of the dependent claims of the present invention. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Also, MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the present invention.

Although it appears the Official Action has attempted to address the features of independent claims 31 and 43 as amended in the *Preliminary Amendment* filed March 15, 2004, it does not appear that the Official Action has taken into consideration any of the arguments regarding a lack of motivation to combine the prior art as presented in the *Response* filed January 14, 2003 (particularly page 3), and in the *Preliminary Amendment* filed March 15, 2004 (particularly pages 13-14). In fact, in the Official Action mailed May 4, 2004 (Paper No. 20040430), the alleged motivation to combine the prior art references appears to be identical to the alleged motivation asserted in the Official Action mailed October 14, 2003 (Paper No. 18). For example, the alleged motivation to combine Kanaya and Yamazaki '996 presented at the top of page 5 of the present Official Action is identical to the alleged motivation presented in the middle of page 3 of the Official Action mailed October 14, 2003. The same is true of the alleged motivation to combine Sukegawa and Yamazaki '996 and Inada and Yamazaki '996. The Official Action has not provided any further arguments or evidence to either support the alleged motivation to combine or to refute the above-referenced arguments presented by the Applicant. In short, the Office has delayed prosecution of the present application by ignoring the Applicant's arguments. The Applicant again respectfully requests that the Official Action provide a response to these arguments or withdraw the

obviousness rejections. The Applicant further respectfully requests that if a further response is deemed necessary, that it be in the form of a non-final Official Action.

A summary of the arguments in the *Response* filed January 14, 2003 (particularly page 3), and in the *Preliminary Amendment* filed March 15, 2004 (particularly pages 13-14) is presented herewith. The Official Action asserts that it would have been obvious to form the connecting wiring of one of Kanaya, Sukegawa and Inada to have a tapered shape, as taught in Yamazaki '996 because Yamazaki '996 teaches that tapering is conventional and required to improve step coverage. However, Kanaya, Sukegawa and Inada teach wirings covered with insulating films in a terminal portion. On the other hand, Yamazaki '996 teaches an interlayer insulating film having a contact hole covered with a wiring. In other words, Yamazaki '996 only teaches that contact holes are conventionally required to be tapered to improve the step coverage of upper-layer wiring lines at contact holes (paragraph [0003], first sentence), which appears to be relied upon by the Official Action as an alleged motivation to combine Yamazaki '996 and the other references. Yamazaki '996 only teaches that the improvement of the step coverage is true for the interlayer insulating film having a contact hole covered with a wiring, not for the wirings covered with insulating films. Therefore, the Applicants believe that there is insufficient motivation or suggestion for combining Yamazaki '996 either with Kanaya, Sukegawa or Inada. For the reasons stated in previous responses, the Applicant further submits that Ukita, Utsumi and Hioki do not teach or suggest that it would have been obvious at the time of the invention to apply the teachings of Yamazaki '996, which teaches a wiring over an interlayer insulating film having a contact hole, to either Kanaya, Sukegawa or Inada, which teach an insulating film over wiring.

In the present application, it is respectfully submitted that the prior art of record, alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the

artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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